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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,019	10/17/2000	Max Rombi	017753-128	4184

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EXAMINER	
PATTEN, PATRICIA A	
ART UNIT	PAPER NUMBER
1654	

DATE MAILED: 11/29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/601,019	Rombi, M.
Examiner	**Art Unit**
Patricia Patten	1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Oct 15, 2002* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1, 3, 5, 16, and 25-28* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1, 3, 5, 16, and 25-28* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

RCE Practice

A request for continued examination under 37 CFR § 1.114, including the fee set forth in 37 CFR § 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR § 1.114, and the fee set forth in 37 CFR § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR § 1.114. Applicant's submission filed on 10/15/02 has been entered.

Claims 1-3, 5, 16 and 25-28 are pending in the application.

Claims 16 *is* drawn to the elected invention per Applicants' arguments (p.1 - Remarks), and will subsequently be examined on the merits along with claims 1-3, 5 and 25-28.

Claims 1-3, 5, 16 and 25-28 have been presented for examination on the merits.

Applicant's arguments pertaining to the rejections made in Paper No. 15 are moot in light of the new rejections *infra.*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasuda et al. (1991). Claims 1, 3, 25 and 26 are drawn to an extract of green tea comprising 20-50% of epigallocatechol gallate (EGCG) and 5-10% of caffeine. Claims are further drawn to wherein the extract comprises 20-30% by mass of EGCG and wherein the extract is an 80% alcoholic extract.

Yasuda et al. (1991) disclosed a composition for decreasing halitosis which contained an 80% alcoholic extract of green tea (Abstract). Applicants disclosed that an 80% alcohol extract inherently contains 20-30% catechols and 5-10% caffeine. Thus, the product must be the same if the steps for preparing are the same:

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are **produced by identical or substantially identical processes**, a *prima facie* case of either anticipation or obviousness has been established." *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

In this case, because Yasuda et al. disclosed the 80% alcoholic extract from green tea, it *must have* inherently contained the claimed percentages of EGCG and caffeine. The inherency of the percentages of the constituents present in the extract flows logically from the Yasuda et al. reference, since it is the same plant material being extracted with the same solvent. Herein is evidence of inherency, and therefore, Yasuda et al. need not explicitly disclose the exact chemical nature of the extract.

Claim Rejections - 35 USC § 103

Claims 5, 16 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. (1991) as applied to claims 1, 3, 25 and 26 above.

Claims 5, 16 and 26-28 are drawn to specific milligram amounts of EGCG and caffeine which are present in a composition.

The teachings of Yasuda et al. (1991) were discussed *supra*.

Yasuda et al. did not specifically disclose the milligram amounts of EGCG and caffeine which are recited in the Instant claims.

The ordinary artisan would have recognized that the claimed amounts of EGCG and caffeine were all within the ratio of EGCG to caffeine which are found in the 80% alcoholic extract of green tea (i.e., 20%:5% = 4:1 for example).

One of ordinary skill in the art would have been motivated to have extracted green tea with a 80% solution on a large scale to produce the claimed amounts of EGCG and caffeine in order to have mass produced the product. The ordinary artisan would have expected that large-scale extractions of green tea would have been more cost efficient and less time consuming than more frequent extractions of small amounts of green tea.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703)308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback is on 703-306-3220 The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

11/28/02

Patricia Patten